

REMARKS

Applicants respectfully request entry of the remarks submitted herein. Claims 1-7 and 9-31 are currently pending. Reconsideration of the pending application is respectfully requested.

The 35 U.S.C. §103 Rejections

Claims 1-4, 6, 9-15, 18-23, 25, 27 and 29-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sarneel (US 2002/0037351; "Sarneel 02") in view of Takashima (US 2001/0055638) and Roberts (US 4,103,038); claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sarneel, Takashima, Roberts and further in view of Gisaw et al. (US 6,558,730); claims 6, 7 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sarneel, Takashima, Roberts and in further view of Sarneel et al. (WO 04/084640; "Sarneel 04"); and claims 11, 16, 17, 26 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sarneel (US 6,663,909; "Sarneel 909"), Takashima and Roberts. These rejections are respectfully traversed.

Independent claims 1 and 11 are currently rejected over "Sarneel 02" or "Sarneel 909", in view of Takashima and Roberts. According to the Examiner, it would have been obvious to modify the formulation in either Sarneel reference to include whey protein in place of or in addition to eggs. Obviousness under §103 requires consideration of the factors set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), including an analysis of the scope and content of the prior art and the differences between the claimed subject matter and the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

As indicated previously, the presently claimed compositions are intended for use as egg replacements in low-cholesterol products. On the other hand, eggs and fat are essential ingredients in the Sarneel compositions (see, for example, Example 5). Because Sarneel does not suggest egg substitute or low cholesterol products, one of ordinary skill in the art would not have been prompted to use or modify the composition of Sarneel to obtain a composition suitable for replacing egg in a bakery product. The Examiner combined Sarneel with Takashima, which discloses microwaveable sponge cake that utilizes low-protein or heat-treated flour, and Roberts,

which discloses an egg substitute comprising from 30% to 75% ultrafiltered whey protein, fats, and emulsifiers. However, neither Takashima nor Roberts teach or suggest a composition that includes starch n-octenyl succinate.

A claim "composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR* at 401. The Courts have clearly indicated that there must be some teaching, suggestion, or incentive to make the claimed invention beyond the mere disclosure of individual components of the claimed invention, either separately or in other combinations. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990). As with the previous rejection, however, the Examiner has provided no rationale as to why a person having ordinary skill in the art would combine the teachings of Roberts with either or both of Sarneel and Takashima, when neither of the latter references teaches or suggests the production of low-cholesterol products.

In addition, the Examiner's allegation that one of ordinary skill would arrive at the presently claimed amounts through "routine experimentation" and that "discovering an optimum value of a result effective variable involves only routine skill in the art" (OA at page 3) is unsupported by any teaching or suggestion in the cited references, either alone or in combination. As the Supreme Court has stated, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*KSR* at 401, quoting *In re Kahn*, 441 F.3d 997, 988 (Fed. Cir. 2006)).

In the present case, a person of ordinary skill in the art would not have been prompted to modify the compositions of Sarneel in view of Takashima and Roberts to arrive at a composition having the particularly claimed ingredients in the particularly claimed amounts. As such, the present claims are patentable over the cited references. Accordingly, Applicants respectfully request that the rejection of the pending claims under 35 U.S.C. §103(a) be withdrawn.

Double Patenting

Claims 11 and 26 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 8 and 17 of US Patent No. 6,663,909 in view of US 2001/0055638.

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Applicants respectfully requests that this rejection be held in abeyance until allowable subject matter is found. At that time, Applicant will consider submitting an appropriate Terminal Disclaimer.

CONCLUSION

Applicants respectfully request that claims 1-7 and 9-31 be allowed. If a telephone call to the undersigned would expedite prosecution, the Examiner is encouraged to do so. Please apply the fee for the enclosed Petition for Extension of Time and any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Date: _____

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